

Amendment in response to
February 8, 2007 final Office action

Atty Dkt No.: 2000P07532US01
Serial No.: 09/742,696

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REMARKS

Claims 1 – 20 remain in the application and stand finally rejected. Claim 17, 19 and 20 are amended. No new matter has been added. Although this Amendment is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claim 19 is amended to recite the additional step of “interfacing a packet network to a private branch exchange (PBX) in an existing private network of a plurality of coupled telephony devices,” which is neither shown nor suggested by any reference of record. Schuster et al. teaches a packet based system with PBX features (i.e., a virtual PBX) to data network telephony devices, e.g., a Voice over Internet Protocol (VoIP) system with VoIP devices. Col. 6, lines 42 – 51. There is nothing in any reference of record to suggest interfacing the virtual PBX of Schuster et al. with a PBX in an existing network. Claims 17 and 20 are similarly amended to recite that the “private branch exchange (PBX) (is) in a private network of a plurality of coupled telephony devices.” There is nothing in any reference of record to teach or suggest a system as recited in claims 1 or 16 that includes a “private branch exchange (PBX) in a private network of a plurality of coupled telephony devices” as claims 17 and 20, which depend from claims 1 and 16, are amended to recite. This amendment to claims 17, 19 and 20 is supported, for example, in the specification by Figure 1, page 1, lines 23 – 39 and page 3, lines 13 – 24. No new matter is added.

Claims 1 – 4 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,446,127 to Schuster et al. in view of published U.S. Patent Application No. 2003/0058277 to Bowman-Arnaud. Claims 5 – 20 are finally rejected as being unpatentable under 35 U.S.C. §103(a) over Schuster et al. and Bowman-Arnaud in view of U.S. Patent No. 6,209,018 to Ben-Sachar et al. The final rejection is respectfully traversed.

Essentially, the final rejection is a repeat of the rejection from the prior Office action mailed July 27, 2006. In responding to the applicants arguments in the previous amendment, the

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final Office action asserts that “[c]ontrary to applicant’s assertions, the teachings of the cited references are not limited as concluded by the applicant [arguments].” However, that is not what applicants have asserted.

The MPEP §2141.02(VI) provides in pertinent part that a “prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)” (emphasis original). In the prior Office action, the applicants pointed to portions of Schuster et al. “that would lead away from the claimed invention.” *Id.* Moreover, “the examiner **must provide evidence** which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not.” MPEP §2143.01 II. (WHERE THE TEACHINGS OF THE PRIOR ART CONFLICT, THE EXAMINER MUST WEIGH THE SUGGESTIVE POWER OF EACH REFERENCE) (emphasis added). Here, the applicants have shown, not just that two references conflict, but that the conflict arises from Schuster et al.

Moreover, as the applicants noted in the prior Office action, in that conflict Schuster et al. teaches away from the combination. “A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, **teaches away** from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)” MPEP §2144.05 III., citations omitted (emphasis added). “It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)” MPEP §2145 X.D.2. citations omitted.

Specifically, as previously noted Schuster et al. teaches a packet based system with PBX features and that uses external devices connected through another intermediate device to provide additional functions to the packet based system. A stated object of Schuster et al. is to “incorporate CLASS and PBX features into a data network telephony system that uses a data network such as the Internet,” i.e., a virtual PBX in a packet based telephone system. Col. 3, lines 38 – 40. So, again, the question must be answered, if one already has PBX features in a

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packet based system, why would one be inclined to add a PBX? "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)" MPEP §2143.01 V. citations omitted. Since, adding a PBX to the Schuster et al. virtual PBX is in conflict with the above stated Schuster et al. object, one would not be so inclined and, further, Schuster et al. teaches away from the combination to result in the present invention.

"The fact that a prior art reference can be modified to show the patented invention does not make the modification obvious **unless the prior art reference suggests** the desirability of the modification. An attempted modification of a prior art reference that is **unwarranted by the disclosure** of that reference is improper." *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (emphasis added). *See also, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation **in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added)); *and see*, MPEP §2143.01 III. (FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS). Therefore, having shown undisputedly that Schuster et al. teaches away from the combination to result in the present invention, *prima facie* obviousness has been rebutted.

Furthermore, adding a PBX to any system based on Schuster et al. "is **unwarranted by the disclosure** of that reference" and so, "is improper." *Supra*, (emphasis added). Further, adding a PBX to any system based on Schuster et al. changes principles of operation of Schuster et al. MPEP §2143.01 VI. (THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE). Applicants assert that, absent improper hindsight, the only conclusion warranted by, and consistent with, the Schuster et al. disclosure is that, there is no need to add a PBX to a Schuster et al. system and, further, no inclination to do

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so. Therefore, the combination of Schuster et al. with Bowman-Amauh neither results in nor suggests the present invention as recited in claims 1 – 4.

The final Office action further asserts that “[t]he applicant to cite (sic) the alternative teachings of the reference does not mean the teachings of the broadly claimed invention taught by the cited arts should not be considered.” To the contrary, it is not the applicants position that only a portion of any reference be considered, but that the entirety of each reference must be considered for all it teaches. Specifically, “the examiner **must** then consider any evidence **supporting the patentability** of the claimed invention, such as any evidence **in the specification** or any other evidence submitted by the applicant.” MPEP §2142 (emphasis added). In particular, what must be considered is that Schuster et al. teaches away from combining to result in the present invention. So, this undisputed fact is sufficient to rebut an assertion of *prima facie* obviousness based on, not just the combination of Schuster et al. with any other reference, but also based on the combination of any other references of record or not of record.

Furthermore, “to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence.” Neither the prior Office action nor the final Office action, reflects anything that might overcome the fact that a PBX is unnecessary. Nor has it been disputed that Schuster et al. teaches away, i.e., nothing has been provided to explain why one would ignore the fact that with a Schuster et al. virtual PBX, there is no motivation to add a PBX. Therefore, absent improper hindsight, the only conclusion warranted by, and consistent with, the Schuster et al. disclosure is that one would not be inclined to add a PBX to a Schuster et al. system. MPEP §2142 (“impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art”).

Therefore, it is undisputed that Schuster et al. teaches away from “a software dispatcher in a telephony Internet server coupled between a packet network and a private branch exchange” as claim 1 recites at lines 2 – 3; it is clear that modifying Schuster et al. to add a PBX changes a principal of Schuster et al. operation; and clear that such a modification would render Schuster et al. unsuitable for its intended purpose. *See also*, claim 7, line 4, claim 12, line 2 – 4, and claim

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16, line 4. So, regardless of what is taught by Bowman-Amauh, the addition of load balancing and synchronously and asynchronously sending messages with Schuster et al., still fails to result in the present invention as recited in claim 1. Neither does the addition of managing "a pool of message threads to balance" and/or "a list of unique integers identifying ... dispatcher clients ... to receive ... messages," as taught by Ben-Sachar et al., add anything to the combination of Bowman-Amauh with Schuster et al. result in the present invention as recited in claims 7, 12 or 16.

Furthermore, since dependent claims include all of the differences with the prior art as the claims from which they depend, the combination of Schuster et al. with Bowman-Amauh, alone or further in combination with Ben-Sachar et al., does not result in or suggest the present invention as recited in claim 2 – 6, 8 – 11, 13 – 15 or 18, which depend from claims 1, 7 and 12, respectively. Reconsideration and withdrawal of the final rejection of claims 1 – 16 under 35 U.S.C. §103(a) over Schuster et al. with Bowman-Amauh, alone or further in combination with Ben-Sachar et al. is respectfully requested.

Regarding the rejection of claims 17, 19 and 20, in "determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983)" MPEP §2141.02(I) (emphasis original). As noted hereinabove, even if one were to combine Schuster et al. with Bowman-Amauh, there is nothing in either reference to suggest adding a "private branch exchange (PBX) in a private network of a plurality of coupled telephony devices" as claims 17 and 20 are amended to recite. Nor is there anything in any reference of record to attach the resulting combination to "a private branch exchange (PBX) in an existing private network of a plurality of coupled telephony devices" as claim 19 is amended to recite. Entry of the amendment, reconsideration and allowance of claims 17, 19 and 20 is respectfully requested.

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The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance, both for the amendment to the claims and for the reasons set forth above, the applicants respectfully request that the Examiner enter the amendment, reconsider and withdraw the rejection of claims 1 – 20 under 35 U.S.C. §103(a) and allow the application to issue.

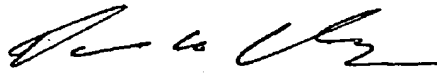
As the applicants have previously noted, MPEP §706 "Rejection of Claims," subsection III, "PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED" provides in pertinent part that

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

(emphasis added). The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney by telephone at (650) 694-5339 for a telephonic interview to discuss any other changes.

Respectfully submitted,

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(Date)


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